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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/684,001
Filing Date: October 10, 2003
Appellant(s): GOLD ET AL.

Mark E. Scott
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 21, 2009 appealing from the Office action

mailed November 14, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal Presented for Application 10/684,207

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

GROUNDS OF REJECTION NOT ON REVIEW

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief.

Claims 1, 17 and 23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of copending Application 10/684,207.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,664,146	Bolin et al.	9-1997
2002/0152181	Kanai et al.	10-2002
2004/0044862	Carlson et al.	3-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 17 and 23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 (dependent from claim 10) of copending Application No. 10/684,207.

Initially, it should be noted that the present application and Application No. 10/684,207, have the same inventive entity. The assignee for both applications is Hewlett-Packard Development Company, L.P.

Claimed subject matter in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as noted below. *See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).*

Furthermore, there is no apparent reason why Appellant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See MPEP § 804.

For example, claim 1 of the instant Application is compared with claim 12, dependent from claim 10 of Application No. 10/684,207. (The rationale in the comparison to claim 1 show bellow also applies to claims 17 and 23 of the instant Application.

Claim 1 in the instant Application is anticipated by patent claim 12 of Application 10/684,207 in that claim 12 of Application 10/684,207 contains all the limitations of claim 1 in

the instant application; thus this rejection comprises a non-statutory obviousness type –

anticipation double patenting rejection.

Instant Application	Application 10/684,207
Claim 1 A method comprising: obtaining information <u>regarding a future backup</u> from one or more backup applications for a plurality of backup jobs;	Claims 10 A method comprising: receiving a list comprising media and at least two backup devices, wherein a first medium in the list is assigned to a first backup device, and a second medium in the list is assigned to a second backup device; ordering the list by physical location of the at least two backup devices; and presenting at least the media portion of the ordered list to a user, wherein receiving the list of media comprises receiving a list of media from a user to be used for one or more future executions of one or more backup jobs associated with the backup devices, said method further comprising, before receiving the list,

calculating a <u>projected</u> number of media for a <u>future execution</u> of at least one of the backup jobs using the information <u>regarding the future backup</u>, said calculating <u>also</u> comprising dividing an average historical backup size of the backup job by an average capacity of a media type associated with the backup job	12. (Original) The method of claim 10, wherein calculating the required number of scratch media comprises for at least one of the future executions, dividing an average historical backup size of the backup job by an average capacity of a media type associated with the backup job.
and presenting the <u>projected</u> number of media to a user.	Claim 10 calculating a required number of scratch media needed for the future executions and presenting the required number of scratch media to the user.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

      Claims 1, 3-5, 8-10, 12-19 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolin et al. (US 5,664,146) in view of Kanai et al. (US 2002/0152181).

      As per **claims 1, 17 and 23**, Bolin discloses a method/system/machine readable medium having stored thereon sequences of instructions comprising: obtaining information regarding a future backup from one or more backup applications for a plurality of backup jobs; **[Bolin discloses migration and backup of data (col. 7, lines 5-8) wherein all cartridges are used for storage of data, and are intended to be written to or read in the future (figure 5 and related text) wherein application programs in the host processor send commands to task module (col. 7, line 27-48)]** calculating a projected number of media for a future execution of at least one of the backup jobs using the information regarding the future backup, and presenting the projected number of media to a user **[Bolin discloses all cartridges are used for storage of data, and are intended to be written to or read in the future (figure 5 and related text) wherein step 260 in figure 6 is can be considered as presenting a projected number of one media to be loaded and used (figure 6 and related text); GUI for "alerting an operating to the need for mounting or demounting a particular data medium" (col. 5, lines 58-63; col. 7, lines 39-40)]**.

      Bolin does not explicitly disclose the details of "said calculating also comprising dividing an average historical backup size of the backup job by an average capacity of a media type associated with the backup job".

Kanai discloses a plurality of backup jobs wherein "said calculating also comprising

dividing an average historical backup size of the backup job by an average capacity of a media

type associated with the backup job" as **["providing the estimation of future storage usage of

the user by the rental storage service provider based on the history of storage usage of the

user; and reporting the estimation to the storage user" (Page 1, Pars. 0018-0019; Pars.

0202, 0225 and 0234) wherein "the rental storage service provider 2 will estimate the future

usage of storage data based on the history record of the usage data stored in the storage

device(s) to report to the rental storage service user 1 the estimation" (Page 4; Par. 0091;

Figure 2 and related text). See recommended capacity graph (Page 8, Par. 0176 and Figure

17)]**.

Bolin et al. (US 5,664,146) and Kanai et al. (US 2002/0152181) are analogous art

because they are from the same field of endeavor of computer memory access and control.

At the time of the invention it would have been obvious to a person of ordinary skill in

the art to modify the storage management method/system as taught by Bolin and further provide

details of a plurality of backup jobs and said calculating comprising, for at least one of the future

executions, dividing an average historical backup size of the backup job by an average capacity

of a media type associated with the backup job as disclosed by Kanai.

The motivation for doing so would have been because Kani discloses **[that rented

storage allows users to be released from the burden of maintenance of store and thereby

have less responsibility of administration (Par. 0005) wherein "the contract user will have

the amount of data more than the currently contracted capacity of 300GB... this display**

screen may provide the user interface which is very easy to operate and easy to understand

for the rental storage service users" (Pages 8-9; Par. 0176)].

Therefore, it would have been obvious to combine Kanai et al. (US 2002/0152181) with

Bolin et al. (US 5,664,146) for the benefit of creating a method/system medium having stored

thereon sequences of instructions to obtain the invention as specified in claims 1, 17 and 23.

As per **claim 3**, the combination of Bolin and Kanai discloses the method of claim 1,

wherein obtaining the information regarding the future backup further comprises obtaining

information for one or more backup devices, each backup device associated with at least one of

the backup jobs **[Bolin discloses all cartridges are used for storage of data wherein each**

device as shown in figure 5 corresponds to a storage job (figure 5 and related text; col. 7,

lines 1-26)].

As per **claim 4**, the combination of Bolin and Kanai discloses the method of claim 3,

wherein presenting the projected number of media comprises presenting the projected number of

media required for each of the backup devices **[Bolin discloses wherein step 260 in figure 6 is**

can be considered as presenting a projected number of media to be loaded and used (figure

6 and related text); GUI for "alerting an operating to the need for mounting or demounting

a particular data medium" (col. 5, lines 58-63; col. 7, lines 39-40)].

As per **claim 5**, the combination of Bolin and Kanai discloses the method of claim 1,

wherein obtaining the information regarding the future backup further comprises obtaining

information for one or more media pools, each media pool associated with at least one of the

backup jobs **[Bolin discloses migration and backup of data (col. 7, lines 5-8) wherein all**

cartridges are used for storage of data, and are intended to be written to or read in the

future (figure 5 and related text) wherein application programs in the host processor send

commands to task module (col. 7, line 27-48). The embodiment of figure 4 also covers

individual media pools (col. 7, line 64-col. 8, line 3) and explains library dataserver

displaying mount messages for a tape subsystem forming part of a plurality of tape

subsystems (col. 9, lines 3-36; figures 4-5 and related text)].

As per **claims 8, 18-19 and 24-25**, the combination of Bolin and Kanai discloses the

method of claim 5, wherein presenting the projected number of media comprises presenting the

projected number of media for each of the media pools **[Bolin discloses library dataserver**

displaying mount messages for a tape subsystem forming part of a plurality of tape

subsystems (col. 9, lines 3-36; figures 4-5 and related text) wherein step 260 in figure 6 can

be considered as presenting a projected number of media to be loaded and used (figure 6

and related text)].

As per **claim 9**, the combination of Bolin and Kanai discloses the method of claim 5,

wherein calculating further comprises using the media pool information to analyzing historical

usage of the media pools as **[Kanai discloses "providing the estimation of future storage**

usage of the user by the rental storage service provider based on the history of storage

usage of the user; and reporting the estimation to the storage user" (Page 1, Pars. 0018-

0019; Pars. 0202, 0225 and 0234)].

As per **claim 10**, the combination of Bolin and Kanai discloses the method of claim 5,

further comprising presenting a report to the user identifying at least one media pool having a

greater amount of media than the projected number of media for the at least one media pool

[Bolin discloses eject messages for media that is not required to be included in the

projected number of media for future storage jobs (figure 5 and related text)].

As per claims **12-13**, the combination of Bolin and Kanai discloses The method of claim

1, further comprising: wherein obtaining the information regarding the future backup further

comprises obtaining information for one or more media pools, each media pool associated with

the backup jobs; and wherein calculating the projected number of media further comprises

totaling the number of media projected for each media pool to be used by the future execution;

wherein the obtaining the information regarding the future backup further comprises obtaining

information for one or more backup devices associated with the backup jobs; and wherein

calculating the projected number of media further comprises totaling the projected number of

media for each backup device to be used by the future execution **[Bolin discloses migration and**

backup of data (col. 7, lines 5-8) wherein all cartridges are used for storage of data, and are

intended to be written to or read in the future (figure 5 and related text) and step 260 in

figure 6 is can be considered as presenting a projected number of one media to be loaded

and used (figure 6 and related text); GUI for "alerting an operating to the need for

mounting or demounting a particular data medium" (col. 5, lines 58-63; col. 7, lines 39-40) and explains having different tape pools (figure 4 and related text). Kanai discloses "providing the estimation of future storage usage of the user by the rental storage service provider based on the history of storage usage of the user; and reporting the estimation to the storage user" (Page 1, Pars. 0018-0019; Pars. 0202, 0225 and 0234) wherein "the rental storage service provider 2 will estimate the future usage of storage data based on the history record of the usage data stored in the storage device(s) to report to the rental storage service user 1 the estimation" (Page 4; Par. 0091; Figure 2 and related text). See recommended capacity graph (Page 8, Par. 0176 and Figures 17 and 28) wherein the total capacity of the storage system is shown and the total recommend capacity for certain time periods is also shown].

As per **claim 14**, the combination of Bolin and Kanai discloses the method of claim 1, wherein calculating further comprises calculating the projected number of media for the future execution of the backup jobs scheduled within a predetermined period of time [**Bolin discloses all cartridges are used for storage of date wherein they are intended to be written to or read in the future (figure 5 and related text) wherein step 260 in figure 6 can be considered as presenting a projected number of media to be loaded and used within a predetermined period of time (figure 6 and related text); note eject messages are sent to the user when media is not longer necessary. Furthermore, Kanai discloses estimation of future storage based on usage history of the user (Page 1, Pars. 0018-0019)**].

As per **claims 15 and 21**, the combination of Bolin and Kanai discloses the method of

claim 1, further comprising receiving from the user a list of one or more media to be used **[Bolin**

discloses cartridge (col. 9, line 51-col. 10, line 43; figure 5 and related text)].

As per **claims 16 and 22**, the combination of Bolin and Kanai discloses the method of

claim 15, further comprising for each media in the list, determining if the media is a valid media

[Bolin discloses "if the wrong volser has been mounted, the host issues a demount job and

then reissues a mount job, starting from step 236" (col. 11, line 52-54)].

Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolin et al.

(US 5,664,146) in view of Kanai et al. (US 2002/0152181) as applied to claims 1 and 5 above,

and further in view of Carlson et al. (US 2004/0044862).

As per **claim 6**, the combination of Bolin and Kanai discloses the method of claim 5, but

does not disclose expressly the details of calculating comprises, for each media pool:

determining an existing number of media in the media pool; calculating the projected number of

media for the future execution using the media pool; and subtracting the existing number from

the projected number.

Carlson discloses of calculating comprises, for each media pool: determining an existing

number of media in the media pool; calculating the projected number of media for the future

execution using the media pool; and subtracting the existing number from the projected number

as ["**a system administrator may move physical volumes from one storage pool to another when managing the tape cartridges in the storage pools. This may be performed if a determination is made that one storage pool needs additional tapes due to an anticipated increase of data maintained in that pool, or one pool needs fewer tape cartridges due to an anticipated decrease in data directed toward that pool" (Page 3, Par. 0044) and details moving a number of physical volumes from a source pool to a target pool (figures 9-10 and related text)**].

Bolin et al. (US 5,664,146), Kanai et al. (US 2002/0152181) and Carlson et al. (US 2004/0044862) are analogous art because they are from the same field of endeavor of computer memory access and control.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the storage management method/system as taught by the combination of Bolin and Kanai and further calculating a projected number of media by determining an existing number of media in the media pool; calculating the projected number of media for the future execution using the media pool; and subtracting the existing number from the projected number as disclosed by Carlson.

The motivation for doing so would have been because Carlson discloses calculating a projected number of media by determining an existing number of media in the media pool; calculating the projected number of media for the future execution using the media pool; and subtracting the existing number from the projected number is done to maintain the optimal number of cartridges in a storage pool [**(par. 0044)**].

Therefore, it would have been obvious to combine Kanai et al. (US 2002/0152181) with

Bolin et al. (US 5,664,146) and Carlson et al. (US 2004/0044862) for the benefit of creating a

method/system medium having stored thereon sequences of instructions to obtain the invention

as specified in claim 6.

As per **claim 7**, the combination of Bolin, Kanai and Carlson discloses the method of

claim 6, wherein determining the existing number further comprises determining if a protected

period for one or more existing data media has expired **[Kanai discloses "the reporting process**

will also be executed if a predetermined period of time has expired" (Par. 0158) which

comprises a time period for the contract for data storage].

(10) Response to Argument

A. Section 103 Rejections over Bolin and Kanai

1. Claims 1, 3-5, 8-10, 12-14, 16-19 and 22-25

Appellant argues the Office action fails to specifically point to what portion of Bolin

actually obtains "information regarding a future backup from one or more backup applications."

In response, this argument has been fully considered, but it is not deemed persuasive.

In response to Appellant's arguments against the references individually, one cannot

show nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re*

Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The combination of Bolin and Kanai discloses obtaining "information regarding a future backup from one or more backup applications" as Bolin discloses [**"host 100 has a task of allocating jobs to devices within PDSD (peripheral data storage device) subsystem" (col. 3, lines 12-13) wherein common jobs for which tape library is used comprise migration and backup of data (col. 7, lines 5-8) wherein all cartridges are used for storage of data, and are intended to be written to or read in the future (figure 5 and related text) wherein application programs in the host processor send commands to task module (col. 7, line 27-48)**]; thus information for jobs (which comprise backup jobs) is obtained in order to allocate storage devices for said jobs. Kanai further discloses this limitation as [**"providing the estimation of future storage usage of the user by the rental storage service provider based on the history of storage usage of the user; and reporting the estimation to the storage user" (Page 1, Pars. 0018-0019; Pars. 0202, 0225 and 0234) wherein "the rental storage service provider 2 will estimate the future usage of storage data based on the history record of the usage data stored in the storage device(s) to report to the rental storage service user 1 the estimation" (Page 4; Par. 0091; Figure 2 and related text). See recommended capacity graph (Page 8, Par. 0176 and Figure 17)**]. Appellant should note that saving/storing data by a user within rental storage system comprises backup procedures from one or more backup applications and that as it is estimated the future storage usage of the user for the rental storage by the rental storage service provider, the rental storage service provider considers either directly/indirectly "backup job information from one or more backups applications for a plurality of backup jobs," as it considers "history of usage"; and provides an estimate of storage that the user will need in order to accommodate backup jobs by the user to the rental storage.

Appellant argues the combination of Bolin and Kanai does not disclose "calculating a projected number... using the information regarding the future backup" as "Bolin's library 16 does not calculate a number of media."

In response, this argument has been fully considered, but it is not deemed persuasive.

In response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

First, the Examiner would like to point out that the pending claims do not include any limitations dictating what the "calculated projected number" may be or discriminating said "projected number" from being any number of devices. Therefore, the "projected number of devices" as claimed, may be any number of devices, including zero, one or all the devices in a storage system.

Based on a first interpretation, Bolin discloses "calculating a projected number... using the information regarding the future backup" as [**"host 100 has a task of allocating jobs to devices within PDSD (peripheral data storage device) subsystem" (col. 3, lines 12-13) wherein common jobs for which tape library is used comprise migration and backup of data (col. 7, lines 5-8);** *thus disclosing obtaining information of a job, which may be a backup job in order to allocate storage device to it.* **Bolin also discloses "a large data set to span several hundred cartridges or cassettes in the case where the storage medium is a tape... the entire data set are likely to be dispersed in a plurality of storage bins located throughout**

the library. The cartridges are identified by their respective volsers. Accordingly, it is

critical that an operator be alerted promptly of the need to mount or demount the

cartridges containing the requested data set, in order for the data processing to continue"

(col. 2, lines 37-47)]; thus calculating or determining the devices in a dataset (which comprises a

number of devices, since the data set may span multiple cartridges or tapes and the host must be

alerted on the need to mount the devices that form the data set) in order to perform jobs requiring

processing of the dataset; which, according to Bolin's disclosure may be back up jobs [See

above]. Appellant should note that all devices in a dataset may be necessary to perform a storage

job (or more specifically, a backup job) and that the dataset does not comprise all the tape

devices in the system, but a grouping of devices; thus an operator is alerted on a number of

devices (or the devices forming the dataset) from the total amount of devices in the system to

mount in order to perform a backup job with the data set in the form of a graphical user interface

(GUI) such as the GUI shown in FIG. 5 and related text of Bolin which comprises multiple

mount messages. Therefore, disclosing determining or calculating a projected number of devices

necessary to perform a storage job or backup job, as claimed.

Additionally, based on another interpretation, Bolin discloses "calculating a projected

number... using the information regarding the future backup" as **["host 100 has a task of**

allocating jobs to devices within PDSD (peripheral data storage device) subsystem" (col. 3,

lines 12-13) wherein common jobs for which tape library is used comprise migration and

backup of data (col. 7, lines 5-8) wherein all cartridges are used for storage of data, and are

intended to be written to or read in the future (figure 5 and related text) wherein in step

236 in fig. 6 "a job request passed to library manager"; *thus disclosing obtaining*

information of a job, which may be a backup job]. Bolin also teaches [**step 260 in figure 6**

which can be considered as presenting a projected number of one media to be loaded and

used (figure 6 and related text); GUI for "alerting an operating to the need for mounting or

demounting a particular data medium" (col. 5, lines 58-63; col. 7, lines 39-40; fig. 5 and

related text) in order to perform the backup job] wherein the Examiner submits that

according to Bolin's disclosure, in a tape library, a mount message requesting a storage device is

sent to the user or operator in response to calculating or projecting that the device is necessary

for performing storage jobs, including backup jobs (within the scope of the disclosure, See

Citations Above); wherein in an embodiment performing backup jobs, mount messages would

only be sent to the operator for certain devices in response to estimating or projecting that those

devices would be necessary. Appellant should note that as "mount messages" are presented to

the operator such as mount messages shown in (FIG. 5 of Bolin), said mount messages are sent

in order to have tape devices (or a calculated projected number of tape devices) mounted in the

system in order to perform requested jobs, which may be backup jobs. The calculated projected

number… using the backup job (as claimed) may be any number of devices necessary to perform

said job, including one device. As mount messages requesting one tape device (in order to

perform job or backup job) are sent, the library as taught by Bolin is calculating a projected

number... using the backup, which may be one or any number of devices requested for mount or

projected necessary.

Kanai clearly discloses "calculating a required number of scratch media needed for one

or more future executions of the… backup jobs," as [**"providing the estimation of future**

storage usage of the user by the rental storage service provider based on the history of

storage usage of the user; and reporting the estimation to the storage user" (Page 1, Pars.

0018-0019; Pars. 0202, 0225 and 0234)]. Appellant should note that saving/storing data by a

user within rental storage system comprises backup procedures from one or more backup

applications; therefore, when estimating the number of future storage usage by a user; the rental

storage service provider is calculating required number of media needed for one or more future

executions of backup jobs. Appellant should further note that the total space necessary for a

future execution of a backup job or any other storage job is directly proportional to the number

of devices in the system when using a tape storage system such as the storage system taught by

Bolin. More specifically, when combining Kanai with Bolin, the total amount of storage

estimated necessary by Kanai may be expressed to the user as a number of devices to mount in

an interface such in GUI (graphical user interface) taught by Bolin in Figure 5 in the form of

mount messages displayed in the user interface to the operator.

Appellant argues the logic in the Office action is inconsistent as "on the one hand

indicating "a projected number of one media" and on the other hand indicating "all the cartridges

in the system is deemed as the projected media"" and "if all the cartridges of the system are the

projected media as alleged by the Office action, there would be no need to calculate the projected

media."

In response, this argument has been fully considered, but it is not deemed persuasive.

It appears that Appellant is reading the pending claims narrower than they appear since

there are no limitations in the pending claims dictating what the projected number of media is or

further limiting the limitations "the projected number of media". Thus, a projected number of

media to be used for a job may be one device or all the cartridges in the system as determined

and calculated by the system. Therefore, the fact that all the cartridges in the system may be the

projected number of media does not mean that there is no need to calculate the projected number

of media or amount of storage space to use. Since in some instances, all cartridges may be

necessary while in other instances, just one cartridge may be. Furthermore, Appellant should

note that since Bolin's disclosure has the ability to use all cartridge or devices included in the

system, it must have the ability to use a partial amount of cartridges or devices in the tape library

system.

Further, it is deemed that as Bolin discloses **[all cartridges are used for storage of data,**

and are intended to be written to or read in the future (figure 5 and related text) wherein

step 260 in figure 6 is can be considered as presenting a projected number of one media to

be loaded and used (figure 6 and related text); GUI for "alerting an operating to the need

for mounting or demounting a particular data medium" (col. 5, lines 58-63; col. 7, lines 39-

40) *wherein, the total of all cartridges in the system is deemed as the number of projected*

media; note that all the cartridges are calculated/deemed necessary for future data storage]

wherein if the library has a mount request for every tape device such as mount requests depicted

in (FIG. 5 of Bolin), the library is requesting mount of all of the devices which are deemed

necessary to perform storage jobs if they are not already mounted; thus, proving a full number of

devices needed for storage jobs.

In view of the above, it is deemed that the combination of Bolin and Kanai discloses all

the limitations required by the pending claims and is proper.

2. Claims 15 and 21

Appellant argues the combination of Bolin and Kanai does not disclose "receiving from the user a list of one or more media to be used" as in Bolin's Figure 5, the lists of devices are not provided by the librarian or user, but are provided to the librarian as a list of things to do and "mounting a specific cartridge as instructed by Bolin's system is not providing Bolin's system a list of media to be used."

In response, this argument has been fully considered, but it is not deemed persuasive.

First, Bolin discloses "receiving from the user a list of one or more media to be used" as **["an operator can request library manager code 70 to provide a list of cartridges on display 25 to pick from based on a particular category (col. 13, line 65-col. 14, lines 1) wherein "Selection of window action "Add to pick list" button 362 brings up the "Add to pick list" window shown in FIG. 14. Note that in the example illustrated in FIG. 14, five volumes with location VLT are shown in highlighted field 402. An operator may select with a mouse 27 the "Select all" action button 404 to select the displaced volser for addition to the pick list" (col. 14, lines 3-24);** *thus, since the operator may add volumes to the list, it is deemed that a list of one or more media to be used is received from the user or operator*]. Further, it is interpreted that as Bolin discloses that the operator mounts a tape device in the tape library, the operator is providing a list of one available storage medium to be used **[Refer to fig. 5 and related text of Bolin where operator mounts tapes in library in response to mount requests]**.

B. Section 103 Rejections over Bolin, Kanai and Carlson

1. Claims 6-7

Appellant's arguments with respect to claims 6-7 parallel those presented with respect to claims 1, 3-5, 8-10, 12-14, 16-19 and 22-25. Accordingly, these arguments are addressed at least in the manner that claims 1, 3-5, 8-10, 12-14, 16-19 and 22-25 have been addressed above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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